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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,719

Applicant(s)

CREAMER ET AL.

Examiner

Jeffrey R. Swearingen

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/29/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 18-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regard to claims 18-19, the claimed invention is an instant message, which is not a tangible embodiment. In regard to claims 20-36, the claimed invention is embodied as a machine readable storage having stored thereon a computer program having a plurality of code sections executable by a machine. A machine readable storage is not necessarily a computer readable medium. A machine readable storage could constitute a piece of paper to be scanned by a device. The Examiner suggests that Applicant amend to a computer program stored on a computer readable medium for claims 20-36. In regard to claim 37, the claimed invention is an instant messaging or chat session client. This is a software program and also is not in a tangible embodiment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 20, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by DeSimone (U.S. Patent No. 6,175,619).
5. In regard to claims 1 and 20, DeSimone discloses *inserting in an instant message (IM) a voice conference identifier comprising a voice conference call list identifying conference call nodes; and*

Art Unit: 2145

transmitting said IM to a recipient selecting said voice conference identifier, a voice conference call between selected ones of said identified conference call nodes is established. DeSimone establishes that IM is a form of chat software. [DeSimone, column 1, lines 39-53] DeSimone discloses initiating a voice conversation between more than one person by way of a chat session. [DeSimone, column 4, lines 30-41, column 5, lines 48-63] By this rationale claims 1 and 20 are rejected.

6. In regard to claims 3 and 22, DeSimone is applied as in claims 1 and 20. DeSimone further discloses *said conference call is established using telephony-based voice communications links over a public switched telephone network (PSTN).* See DeSimone, Figure 1, item 130. By this rationale claims 3 and 22 are rejected.

7. In regard to claims 4 and 23, DeSimone is applied as in claims 1 and 20. DeSimone further discloses *said voice conference call list specifies telephone numbers for said identified conference call nodes.* DeSimone calls the party's telephone numbers, which means that the telephone numbers are specified for the conference call nodes. See DeSimone, column 5, lines 48-63. By this rationale claims 4 and 23 are rejected.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-13, 16, 18-19, 25-32, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone in view of Bogard (U.S. Patent No. 6,757,365).

10. In regard to claims 6, 7, 9, 10, 11, 25, 26, 28, 29, 30 and 37, DeSimone is applied as in claim 1. DeSimone fails to disclose the use of icons to establish a voice conference. However, Bogard discloses establishing a voice conference using an icon. [Bogard, Figure 2, item 104]. It would be obvious to one of ordinary skill in the art to use icons for many purposes with the DeSimone invention, including initiating

Art Unit: 2145

a voice conference, to allow for a user-friendly interface. The Examiner interprets a selectable signal to be an icon that can be clicked on by the user, as demonstrated in the Bogard reference but is also well known in the art. While the Bogard reference only shows the usage of a single icon, the Bogard reference is also communicating with a single user. It would be further obvious to one of ordinary skill in the art to have an icon for each user that is being communicated with to establish a multi-person voice conference, in order to simplify the setup for the user and save computing cycles used in initiating the setup for each user individually. In special regard to claim 37, the conventional IM processor is considered inherent to any Instant Messenger system. By this rationale claims 6, 7, 9, 10, 11, 25, 26, 28, 29, 30 and 37 are rejected.

11. In regard to claims 16 and 35, DeSimone and Bogard are applied as in claims 9 and 28.

DeSimone further discloses *said conference call is established using telephony-based voice communications links over a public switched telephone network (PSTN)*. See DeSimone, Figure 1, item 130. By this rationale claims 16 and 35 are rejected.

12. In regard to claims 13 and 32, DeSimone and Bogard are applied as in claims 9 and 28.

DeSimone further discloses *said voice conference call list specifies telephone numbers for said identified conference call nodes*. DeSimone calls the party's telephone numbers, which means that the telephone numbers are specified for the conference call nodes. See DeSimone, column 5, lines 48-63. By this rationale claims 13 and 32 are rejected.

13. In regard to claims 8, 12, 18-19, 27, and 31, DeSimone is applied as in claim 1 and DeSimone and Bogard are applied as in claims 9, 20 and 28. The limitations of claims 8, 12, 18-19, 27 and 31 are considered by the Examiner to be inherent to the combination of DeSimone and Bogard as shown in the above rejection in paragraph 10. Upon initiating an Internet Messenger initiated Voice Chat by clicking the icon in Bogard, Figure 2, item 104 or Bogard, Figure 1, item 104, embedded computer program code would inherently establish the necessary voice communication links as dictated by the instant message. This can be conveyed by the instant message claimed in claims 18-19, as inherently shown in Bogard, Figure 2. The header, message, and voice conference identifier of claims 18-19 are all inherent aspects of Bogard, Figure 2. By this rationale claims 8, 12, 18-19, 27, and 31 are rejected.

Art Unit: 2145

14. Claims 2, 5, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone in view of Bala et al. (U.S. Patent No. 6,650,747).

15. In regard to claims 2 and 21, DeSimone is applied as in claims 1 and 20. DeSimone fails to disclose the use of Voice over IP communication links. However, Bala discloses voice communications utilizing Voice over IP. See Bala, column 6, lines 16-28. It would be obvious to one of ordinary skill in the art to use Bala with DeSimone for the purpose of allowing a voice conference to occur over the Internet. [Bala, column 1, lines 60-64] DeSimone gives motivation for the combination by stating that it is desirable to avoid simply running a voice chat layer over a text chat session so as to create private voice chat functionality and improve quality of voice transmission. [DeSimone, column 1, line 65 – column 2, line 14] By this rationale claims 2 and 21 are rejected.

16. In regard to claims 5 and 24, DeSimone is applied as in claims 1 and 20. DeSimone fails to disclose specifying IP addresses for conference call nodes. As previously shown in the rejection for claims 2 and 21, Bala teaches the use of Voice over IP communication links. The Examiner has already given motivation for the combination of DeSimone and Bala in the rejection for claims 2 and 21. Since Bala discloses Voice over IP, the specifying of IP addresses for conference call nodes is inherent to Voice over IP. By this rationale claims 5 and 24 are rejected.

17. Claims 15, 16, 33-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone in view of Bogard and further in view of Bala.

18. In regard to claims 15 and 34, DeSimone and Bogard are applied as in claims 9 and 28. DeSimone and Bogard fail to disclose the use of Voice over IP communication links. However, Bala discloses voice communications utilizing Voice over IP. See Bala, column 6, lines 16-28. It would be obvious to one of ordinary skill in the art to use Bala with DeSimone and Bogard for the purpose of allowing a voice conference to occur over the internet. [Bala, column 1, lines 60-64] DeSimone gives motivation for the combination by stating that it is desirable to avoid simply running a voice chat layer over a text chat session so as to create private voice chat functionality and improve quality of voice transmission. [DeSimone, column 1, line 65 – column 2, line 14] By this rationale claims 15 and 34 are rejected.

Art Unit: 2145

19. In regard to claims 17, 33 and 36, DeSimone and Bogard are applied as in claims 9 and 28. DeSimone and Bogard fail to disclose specifying IP addresses for conference call nodes. As previously shown in the rejection for claims 15 and 34, Bala teaches the use of Voice over IP communication links. The Examiner has already given motivation for the combination of DeSimone, Bogard and Bala in the rejection for claims 15 and 34. Since Bala discloses Voice over IP, the specifying of IP addresses for conference call nodes is inherent to Voice over IP. By this rationale claims 17, 33 and 36 are rejected.

Double Patenting

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/910,271. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims have the same limitations except that the embodiment is an e-mail communication method instead of an instant messaging or chat communication method. Both communication methods are commonly utilized in Internet communication, and the aforementioned references in the rejections above mention e-mail as a common option to instant messaging or chat for initiating communications, including voice communications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2145

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See MPEP § 804.

22. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/910,270. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention claimed is an e-mail variant of the instant application. Unlike the double patenting rejection with Application No. 09/910,271, the claims are worded and ordered differently in 09/910,270 when compared to the instant application. However, the substance of the claims is the same except for the embodiment. For example, in claim 1 of the exemplary application, there is an e-mail communication method comprising the steps of: inserting in an e-mail message a voice communications identifier; transmitting said e-mail message to a recipient; and, responsive to said recipient selecting said voice communications identifier, establishing a voice communications link with said recipient. In the instant application, claim 1 is for an instant messaging or chat (IM/chat) communication method comprising the steps of: inserting in an instant message (IM) a voice conference identifier comprising a voice conference call list identifying conference call nodes; transmitting said IM to a recipient at a recipient node, wherein responsive to said recipient selecting said voice conference identifier, a voice conference call between selected ones of said identified conference call nodes is established. Other than the minor wording differences and the embodiment, the substantial difference is that in the instant application, there is the ability to have multiple voice communication links or a plurality of communication links. It would be obvious to one of ordinary skill in the art to establish multiple links to allow more people to talk to each other if the technology exists to establish a single link.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

23. Claims 1-37 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-44 of copending Application No. 09/910,187. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Art Unit: 2145

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: As shown in the above two double patenting rejections, one application seems to be for a single voice communication link and another seems to be for establishing a plurality of communications links, which would be obvious to one of ordinary skill in the art. In this case, the exemplary application is the same embodiment as the instant application: an instant message communication method. As in the rejection against 09/910,270, the substance of the claims is largely the same except for establishing a plurality of links. Unlike the rejection against 09/910,270, 09/910,187 is the same embodiment as the instant application. The rejection against 09/910,270 herein is largely duplicated against 09/910,187, with the exception that the instant application is not in a different embodiment from the exemplary application for this rejection.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See MPEP § 804.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. Boyer et al., U.S. Pub. No. 2002/0143876, which deals with initiating a voice conference with multiple persons by selecting icons that show the current status of the users. The Examiner believes this to be the equivalent of the disclosed invention, but has utilized substantially older prior art in the rejection.

26. Kirmse et al., U.S. Patent No. 6,669,125, which deals with a game and messenger system that allows for voice chat.


27. Busey et al., U.S. Patent No. 6,377,944, dealing with a call center which supports voice over IP communication and Internet chat.

Art Unit: 2145

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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